

ESTTA Tracking number: **ESTTA244566**

Filing date: **10/23/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Intesa Sanpaolo S.p.A.		
Entity	Corporation	Citizenship	Italy
Address	One William Street New York, NY 10004 UNITED STATES		

Attorney information	Laura Popp-Rosenberg Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES lpopp-rosenberg@frosszelnick.com, ddonahue@fzlz.com Phone: (212) 813-5900		
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### Applicant Information

Application No	77392821	Publication date	09/23/2008
Opposition Filing Date	10/23/2008	Opposition Period Ends	10/23/2008
Applicant	One William Street Capital Management, L.P. 1271 Ave of Americas New York, NY 10019 UNITED STATES		

### Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: Financial services, namely, asset management services, investment management services, and investment advisory services
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### Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

### Mark Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ONE WILLIAM STREET		
Goods/Services	Banking and other financial services as described in the attached Notice of Opposition		

Attachments	Notice of Opposition (F0367276).PDF ( 7 pages )(27740 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Laura Popp-Rosenberg/
Name	Laura Popp-Rosenberg
Date	10/23/2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77/392,821

-----X	:	
INTESA SANPAOLO S.p.A.,	:	
	:	
Opposer,	:	
	:	Opposition No. _____
- against -	:	
	:	
ONE WILLIAM STREET CAPITAL	:	
MANAGEMENT, L.P.,	:	
	:	
Applicant.	:	
-----X		

**NOTICE OF OPPOSITION**

Opposer Intesa Sanpaolo S.p.A. (“Opposer”), a corporation organized and existing under the laws of the Republic of Italy with a principal place of business in the United States at One William Street, New York, New York 10004, believes it would be damaged by the issuance of a registration for the trademark ONE WILLIAM STREET CAPITAL as applied for by One William Street Capital Management, L.P. (“Applicant”) in Application Serial No. 77/392,821 filed on February 8, 2008 for “[f]inancial services, namely, asset management services, investment management services, and investment advisory services” in International Class 36, and therefore opposes same. As grounds for its opposition, Opposer, by its attorneys, Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Opposer is a major international banking group, formed as an amalgamation of a number of previously independent Italian banking and financial institutions. Among Opposer’s many banking components is its Investment Banking Division, which is active in all aspects of investment banking, from investment advising to brokering and dealing in equity and debt

markets, as well as structured finance, mergers and acquisitions, project finance and securitization investment banking services.

2. One of Opposer's predecessor component entities, Banca Commerciale Italiana ("BCI"), first opened a branch in New York City on William Street in 1918. In 1981, BCI purchased the building located at One William Street (the "One William Street Address"), located at the intersection of William and South William Streets, two blocks off Wall Street in the financial district of lower Manhattan.

3. BCI relocated to the One William Street Address upon completion of reconstruction in 1984, and it and its successors, including Opposer, have continuously conducted business from that location since that time.

4. The name of the Building has changed as Opposer's corporate name has changed. Initially it was the "BCI Building," then the "Intesa-BCI Building," and, since the latest merger and name change on January 1, 2007, the Building has been named the "Intesa Sanpaolo Building."

5. Opposer actively encourages the public to associate the One William Street Address with Opposer. For example, the name plate located prominently above the main entrance of the Building reads "INTESA SANPAOLO ONE WILLIAM STREET."

6. No financial institution unaffiliated with Opposer has had any connection with the One William Street Address since 1981.

7. By virtue of Opposer's decades-long occupation of the One William Street Address, and Opposer's activities to encourage association of the One William Street Address

and ONE WILLIAM STREET mark with Opposer, the One William Street Address and the ONE WILLIAM STREET mark (“Opposer’s Mark”) have become known to the trade and to the relevant consuming public as identifying and signifying Opposer and its services exclusively and uniquely.

8. Upon information and belief, Applicant is a Delaware limited liability company located and doing business at 1271 Avenue of the Americas, New York, New York 10019.

9. Upon information and belief, on February 8, 2008, Applicant filed intent-to-use Application Serial No. 77/392,821, the application herein opposed (the “Application”), for the mark ONE WILLIAM STREET CAPITAL (“Applicant’s Mark”) for “[f]inancial services, namely, asset management services, investment management services, and investment advisory services” in International Class 36.

10. Upon information and belief, the “ONE WILLIAM STREET” portion of Applicant’s Mark is a reference to the One William Street Address where Opposer’s Americas headquarters have been located since the early 1980s.

11. Upon information and belief, Applicant had not made use in commerce of Applicant’s Mark prior to the filing date of the Application.

12. Applicant’s Mark is identical and/or highly similar to the One William Street Address and Opposer’s Mark. Applicant’s Mark incorporates the One William Street Address and Opposer’s Mark in their entirety. Moreover, the inclusion of the generic word “CAPITAL” in Applicant’s Mark does not distinguish Applicant’s Mark from the One William Street Address and Opposer’s Mark and, in fact, only serves to reinforces the connection.

13. The services identified in the Application are closely related to services Opposer offers in the United States, including services Opposer conducts at its One William Street Address.

FIRST CLAIM FOR RELIEF UNDER SECTION 2(d)

14. Opposer repeats the allegations contained in paragraphs 1 through 13 as if fully set forth herein.

15. The One William Street Address and Opposer's Mark have been associated exclusively with Opposer since a date prior to any date on which Applicant may rely.

16. Applicant's Mark is substantially similar to in meaning, appearance and commercial impression to the One William Street Address and Opposer's Mark.

17. By virtue of the long standing association between Opposer and both the One William Street Address and Opposer's Mark, and the goodwill associated with them, the registration of Applicant's Mark for services highly similar to services provided by Opposer is likely to cause confusion or cause mistake or to deceive the purchasing public into mistakenly believing that Applicant's services offered under Applicant's Mark originate from, come from or are otherwise associated with Opposer, or that Applicant's goods are endorsed, sponsored or in some way connected with Opposer, all in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

18. Registration to Applicant of Applicant's Mark would be inconsistent with the prior exclusive association between Opposer and ONE WILLIAM STREET, and threatens destruction of Opposer's investment and goodwill inherent in Opposer's Mark and reputation.

19. By reason of the foregoing, Opposer is likely to be harmed by registration of Application Serial No. 77/392,821 for Applicant's Mark.

SECOND CLAIM FOR RELIEF UNDER SECTION 2(a)

20. Opposer repeats the allegations contained in paragraphs 1 through 19 as if fully set forth herein.

21. Since long before any date on which Applicant can rely, the One William Street Address and Opposer's Mark have been exclusively associated with Opposer and have come to identify Opposer's services exclusively.

22. There is no relationship between Opposer and Applicant, and Opposer has not authorized Applicant's use or registration of Applicant's Mark in connection with any goods or services.

23. Applicant's Mark is the same as or a close approximation of the One William Street Address and Opposer's Mark.

24. Because of the reputation of Opposer, the One William Street Address and Opposer's Mark, the public, upon seeing Applicant's Mark, would associate it with the One William Street Address and Opposer's Mark and therefore with Opposer, and would wrongly presume a connection between Applicant's services and Opposer.

25. As a result, Applicant's Mark consists of matter which falsely suggests a connection with an institution, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

26. By reason of the foregoing, Opposer is likely to be harmed by registration of Application Serial No. 77/392,821 for Applicant's Mark.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that the registration sought by Application Serial No. 77/392,821 be denied.

Dated: New York, New York  
October 23, 2008

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 

David Donahue  
Laura Popp-Rosenberg

866 United Nations Plaza  
New York, New York 10017  
(212) 813-5900

*Attorneys for Opposer Intesa Sanpaolo S.p.A.*



**CERTIFICATE OF SERVICE**

I hereby certify that I caused a copy of the foregoing Notice of Opposition to be served by First Class mail, postage prepaid, upon Applicant's correspondence of record, Scott M. Kareff, Esq., Schulte Roth & Zabel LLP, 919 Third Avenue, New York, NY 10022-3902, this 23rd day of October, 2008.

A handwritten signature in black ink, appearing to read "David Donahue", written over a horizontal line.

David Donahue